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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,633	01/29/2004	Richard S. Smith	59503US002	5407

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EXAMINER	
MARCHESCHI, MICHAEL A	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/767,633	SMITH ET AL.	
	Examiner	Art Unit	
	Michael A. Marcheschi	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15,17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Applicant's election with traverse of Group I, claims 1-15 in the reply filed on 4/27/06 is acknowledged. The traversal is on the ground(s) that the search for the elected invention would include a search for the non-elected invention. This is not found persuasive because, as defined in the restriction, the inventions have acquired a separate status in the art as shown by their different classifications and a search for the method claims (class 451) is not required for the composition claims (class 106). The requirement is still deemed proper and is therefore made FINAL.

However, the non elected invention will be rejoined once the elected invention is found allowable.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 and 17-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for all *non silicon* based or substantially silicon-free oil lubricants, does not reasonably provide enablement for all oil lubricants (i.e. silicone oil). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The claims define an oil lubricant, however, the specification only enables the use of non-silicon based lubricants or substantially silicon-free oil lubricants (see page 5, lines 12-13). The broad interpretation of oil lubricants, in the claims, encompasses any oil lubricant (i.e. silicone oil is an oil lubricant) and thus the claims, as drafted, are not within the scope of enablement of the specification (such a disclosure in the specification does not support the breadth of the instant claims).

Claims 1-5, 7-8, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or in the alternative under 35 U.S.C. 103(a) as obvious over Martin et al. (027).

Martin teaches in the abstract, column 4, line 67-column 6, line 60 and column 7, lines 26-8, line 48, a car polishing composition comprising 0-74.5% by weight volatile linear or cyclic siloxanes (claimed materials), 0-12% by weight of an abrasive (silica), 0.5-6% by weight of a surfactant (emulsifier), 0-74.5 of a solvent (these are volatile hydrocarbons), a thickener and 25-85% by weight water. Column 7, lines 26 and column 12, lines 7 defines that oleic acid (this component is known to be used irrespective of its purpose) is added as a separate component

(thus it is the examiners position that this acid will be part of the final composition or at least is part of the initial composition). Other materials commonly employed in automotive polishes can be used (column 8, line 47-48).

The claimed invention is anticipated by the reference because the reference teaches a composition which comprises all of the claimed components. It is the examiners position that this acid will be part of the final composition or at least is part of the initial composition, which applicants do not distinguish over. With respect to the absence of nonvolatile silicon materials, it is the examiners position that the hydrocarbonoxy end-blocked branched organopolysiloxanes, which are fluid, is volatile absent evidence to the contrary and since applicants do not define the extent of non-volatility. With respect to the boiling point of the volatile siloxane, since the material is the same it inherently has the same boiling point. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention because, as defined above, it is the examiners position that the hydrocarbonoxy end-blocked branched organopolysiloxanes, which are fluid, is volatile absent evidence and since applicants do not define the extent of non-volatility. In addition, since the reference uses the same volatile siloxanes they are expected (103) to have the same boiling point.

Claim 6 is rejected under 35 U.S.C. 103(a) as obvious over Martin et al. (027) in view of Ogawa.

Ogawa teaches in column 2, lines 12-14 and column 3, lines 10-13 conventional sizes for abrasives (alumina) when used in polishing formulations.

The size of the abrasive is obvious because the primary reference utilizes an abrasive that is finely divided and although the size is not specifically defined, one skilled in the art would have found the size of the abrasive to be dependent on the results desired. In view of this, one skilled in the art would have found it obvious to use any known conventional abrasive size, such as the size defined by the secondary reference, as the abrasive particles size according to the primary reference because this abrasive particle size is conventionally known to provide the necessary abrasive action in polishing compositions (one skilled in the art would have appreciated the size required to achieve polishing, said size being conventional in the art, as is clearly shown by the secondary reference). Finally, finely divided reads on a micron size.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as obvious over Martin et al. (027).

The primary reference teaches a broad composition comprising all of the claimed components and amounts of the water, abrasive and siloxane. With respect to the amount of oleic acid, column 12, line 7 defines that oleic acid is added as a separate component in a specified amount and it is the examiners position that the skilled artisan would have appreciated that similar amounts (close to 6%) of this component can be added to the broad disclosure of the polishing material of the reference.

Claim 12-13 are rejected under 35 U.S.C. 103(a) as obvious over Martin et al. (027) in view of Ogawa.

The primary reference teaches a composition that comprises all of the claimed components and although this reference does not define that the abrasive is alumina, one skilled

in the art would have found the type of the abrasive obvious in view of the statement made in column 7, lines 51-53 (implies any conventional abrasive can be used). In view of this, one skilled in the art would have found it obvious to use any known conventional abrasive, such as the one defined by the secondary reference, as the abrasive particles according to the primary reference because this abrasive particle is conventionally known to provide the necessary abrasive action in polishing compositions (one skilled in the art would have appreciated the abrasive required to achieve polishing, said abrasive being conventional in the art, as is clearly shown by the secondary reference).

Claim 14 is rejected under 35 U.S.C. 103(a) as obvious over Martin et al. (027) in view of Sejpka et al.

Sejpka et al. teaches in the abstract and column 5, lines 49-60 and column 6, line 67-column 7, line 2 conventional amounts for thickener materials that are known to be added to polishes similar to the polishing of the primary reference.

The primary reference teaches a broad composition comprising all of the claimed components, wherein the broad composition contains the claimed amounts of volatile cyclic siloxane, solvent, water, abrasive and surfactant (emulsifier). This reference is silent as to the (1) specific abrasive, (2) amount of thickener and (3) amount of oleic acid in the broad composition..

With respect to the amount of oleic acid, column 12, line 7 of the primary reference defines that oleic acid is added as a separate component in a specified amount and it is the examiners position that the skilled artisan would have appreciated that similar amounts (close to 6%) of this component can be added to the broad disclosure of the polishing material of the

reference. With respect to the specific abrasive, although the primary reference does not define that the abrasive is alumina, one skilled in the art would have found the type of the abrasive obvious in view of the statement made in column 7, lines 51-53 (implies any conventional abrasive can be used). In view of this, one skilled in the art would have found it obvious to use any known conventional abrasive, such as the one defined by the secondary reference, as the abrasive particles according to the primary reference because this abrasive particle is conventionally known to provide the necessary abrasive action in polishing compositions (one skilled in the art would have appreciated the abrasive required to achieve polishing, said abrasive being conventional in the art, as is clearly shown by the secondary reference). With respect to thickener concentration, the primary reference specifically teaches that this can be added and it is the examiners position that this would imply to the skilled artisan that the amounts used are generally known to be conventional amounts as employed in the polishing art. In view of this, the amount for the thickener component in the composition according to the primary reference would have been obvious because the secondary reference teaches that the claimed amount is a conventionally known concentration to be used in polishes (for cars).

Claims 15 is rejected under 35 U.S.C. 103(a) as obvious over Martin et al. (027).

The reference teaches a composition which is made by mixing all of the components together and although the process might not be in two separate stages (the emulsification step and the mixing (combining with abrasives)), no distinction is seen to exist because the change in sequence of adding ingredients would have been obvious to one of ordinary skill in the art absent evidence to the contrary. *In re Gibson* 5 USPQ 230. In addition, it is the examiners position that

the initial formation of an emulsion would have been obvious to the skilled artisan in order to maximize the homogeneity of the water and siloxane prior to the addition of the abrasive.

The following rejection is an alternative rejection to the one defined above with Martin as the primary reference (assuming arguendo about the oleic acid).

Claims 1-15 and 17 and 18 are rejected under 35 U.S.C. 103(a) as obvious over Martin et al. (027) in view of Brandl (622), Owaga and Sejpka et al.

Brandl et al. teaches that it is conventionally known to incorporate various oils (column 5, lines 57-63) in an amount of (0.3-3%) and lemon oil fragrance (column 8, lines 39-44) in an amount of 0.05-about 1% to car polishes (column 9, lines 20-22 and column 10, line 19).

Martin teaches that in addition to 0-74.5% by weight volatile linear or cyclic siloxanes (claimed materials), 0-12% by weight of an abrasive (silica), 0.5-6% by weight of a surfactant (emulsifier), 0-74.5 of a solvent (these are volatile hydrocarbons), a thickener and 25-85% by weight water, the composition can contain other materials commonly employed in automotive polishes can be used (column 8, line 47-48). This statement makes it obvious to the skilled artisan to incorporate any known additive that is conventionally known for automobile polishes. Since oils, as shown by Brandl et al., are known to be included in this type of composition, the use therefore is well within the scope of the skilled artisan in view of the statement made by Martin. With respect to the absence of nonvolatile silicon materials, it is the examiners position that the hydrocarbonoxy end-blocked branched organopolysiloxanes, which are fluid, defined by Martin, is volatile absent evidence to the contrary and since applicants do not define the extent of

non-volatility. With respect to the boiling point of the volatile siloxane, since the material disclosed by Martin are the same they are expected to have the same boiling point.

With respect to claim 6, the size of the abrasive is obvious because the primary reference utilizes an abrasive that is finely divided and although the size is not specifically defined, one skilled in the art would have found the size of the abrasive to be dependent on the results desired. In view of this, one skilled in the art would have found it obvious to use any known conventional abrasive size, such as the size defined by Ogawa, as the abrasive particles size according to the primary reference because this abrasive particle size is conventionally known to provide the necessary abrasive action in polishing compositions (one skilled in the art would have appreciated the size required to achieve polishing, said size being conventional in the art, as is clearly shown by Ogawa). Finally, finely divided reads on a micron size.

With respect to claims 9-11 the primary reference teaches a broad composition comprising all of the claimed components and amounts of the water, abrasive and siloxane. With respect to the amount of oil, Brandl et al. specifically teaches an amount for this conventional car polish component and thus in view of the statement made by the primary reference the skilled artisan would have appreciated the use of conventional components in conventional amounts.

With respect to claims 12-13, the primary reference teaches a composition that comprises all of the claimed components and although this reference does not define that the abrasive is alumina, one skilled in the art would have found the type of the abrasive obvious in view of the statement made in column 7, lines 51-53 (implies any conventional abrasive can be used). In view of this, one skilled in the art would have found it obvious to use any known conventional

abrasive, such as the one defined by the secondary reference, as the abrasive particles according to the primary reference because this abrasive particle is conventionally known to provide the necessary abrasive action in polishing compositions (one skilled in the art would have appreciated the abrasive required to achieve polishing, said abrasive being conventional in the art, as is clearly shown by the secondary reference).

With respect to claim 14, the references as combined above, teaches a broad composition comprising all of the claimed components, wherein the broad composition contains the claimed amounts of volatile cyclic siloxane, solvent, water, abrasive, oil and surfactant (emulsifier). The reference, as combined above, are silent as to the (1) specific abrasive, (2) amount of thickener. With respect to the specific abrasive, although the primary reference does not define that the abrasive is alumina, one skilled in the art would have found the type of the abrasive obvious in view of the statement made in column 7, lines 51-53 (implies any conventional abrasive can be used). In view of this, one skilled in the art would have found it obvious to use any known conventional abrasive, such as the one defined by Owaga, as the abrasive particles according to the primary reference because this abrasive particle is conventionally known to provide the necessary abrasive action in polishing compositions (one skilled in the art would have appreciated the abrasive required to achieve polishing, said abrasive being conventional in the art, as is clearly shown by the secondary reference). With respect to thickener concentrations, the primary reference specifically teaches that this can be added and it is the examiners position that this would imply to the skilled artisan that the amounts used are generally known to be conventional amounts as employed in the polishing art. In view of this, the amounts for the thickener component in the composition according to the primary reference would have been

obvious because Sejpka et al. teaches that the claimed amount is a conventionally known concentration to be used in polishes (for cars).

With respect to claim 15, the reference primary reference in combination with Brandl et al. teach a composition which is made by mixing all of the components together and although the process might not be in two separate stages (the emulsification step and the mixing (combining with abrasives)), no distinction is seen to exist because the change in sequence of adding ingredients would have been obvious to one of ordinary skill in the art absent evidence to the contrary. *In re Gibson* 5 USPQ 230. In addition, it is the examiners position that the initial formation of an emulsion would have been obvious to the skilled artisan in order to maximize the homogeneity of the water and siloxane prior to the addition of the abrasive.

Claims 1-5, 17 and 18 are rejected under 35 U.S.C. 102(e) as anticipated by or in the alternative under 35 U.S.C. 103(a) as obvious over Scheper (153).

Scheper teaches in column 4, lines 57-65, column 5, line 20-21, column 7, line 21, column 9, line 63, column 10, line 17, column 13, lines 5-10 and the claims, a composition comprising a volatile linear or cyclic siloxanes (claimed materials with the claimed boiling point), an abrasive, an emulsifier, a thickener, an oil (wrinkle reducing agent), water and an alcohol (these are volatile hydrocarbons).

The claimed invention is anticipated by the reference because the reference teaches a composition which comprises all of the claimed components. Although the composition and/or oil are not used for the same purpose, the reference composition can still contain all of the claimed components, irrespective of its purpose. With respect to the absence of nonvolatile

silicon materials, no such materials are included in the reference composition. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention because the reference teaches all of the claimed components and thus one skilled in the art would have broadly envisioned the claimed composition.

Claims 6-8, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as obvious over Scheper (153).

The reference teaches all of the claimed component except a literal recitation of alumina abrasive and its size. In addition, the method of claim 15 is not literally defined.

With respect to the use of alumina abrasive and corresponding size, the reference teaches abrasives, in general, and it is the examiners position that one skilled in the art would have appreciated what material constitutes an abrasive, alumina being conventional. The size is also obvious to the skilled artisan through routine experimentation and optimization of the abrasive character of the composition.

With respect to claim 15, the reference teach a composition which is made by mixing all of the components together and although the process might not be in two separate stages (the emulsification step and the mixing (combining with abrasives)), no distinction is seen to exist because the change in sequence of adding ingredients would have been obvious to one of ordinary skill in the art absent evidence to the contrary. *In re Gibson* 5 USPQ 230. In addition, it is the examiners position that the initial formation of an emulsion would have been obvious to the skilled artisan in order to maximize the homogeneity of the water and siloxane prior to the addition of the abrasive.

Applicant's arguments with respect to all the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MM
6/05

MICHAEL MARCHESCHI
PRIMARY EXAMINER